



UNITED STATES PATENT AND TRADEMARK OFFICE

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re: Williams et al. : Decision on Petition under
Serial No. 09/664,130 : 37 CFR 1.181 for
Filed : September 18, 2003 : Entry of Reply Brief

For: GAS GENERANTS CONTAINING
SILICONE FULES

This is a decision on the petition under 37 CFR 1.182, filed December 05, 2003 for review of the decision not entering the reply brief filed on September 2, 2003 and November 3, 2003. This petition is being as a petition under 37 CFR 1.181. There is no fee for this petition.

On July 2, 2003, an Examiners Answer was mailed.

On September 2, 2003 applicant filed a reply brief that included three Exhibits.

On October 1, 2003, a decision not to enter the reply brief was mailed. The decision stated that the reply brief was not filed in triplicate; the exhibits need to be filed separately and are subject to 37CFR 1.116 and 37 CFR 1.195. Additionally, the decision indicated that no justification for entry of the Exhibits as required under 37CFR 1.116 and 37CFR 1.195.

On November 3, 2003 applicant filed a corrected reply brief in triplicate and included justification for entry of the Exhibits.

On December 4, 2003, the examiner denied entry of the reply brief indicating that the two months from the Examiners Answer had passed and thus the reply brief was not timely.

Applicant filed the instant petition on December 5, 2003.

With respect to the timeliness of the reply brief filed on November 3, 2003, it is noted that the examiner included the following statement in the letter mailed October 1, 2003: *"Therefore, Paper No. 17 is not a reply brief, as characterized, as it stands non-entered. The time period for appellants to file their reply brief continues to run 2 months from July 02, 2003. This time period may be extended up to 5 months in accordance with 37 CFR 1.136(a)."*

37 CFR 1.136(a) allows for extensions of time five months after a time period unless: (i) Applicant is notified otherwise in an Office action; (ii) The reply is a reply brief submitted pursuant to 37 CFR 1.193(b); ...". Given that the examiner explicitly indicated that the response

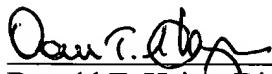
may be extended up to 5 months from July 2, 2003, an interpretation of this statement could lead one to assume the examiner was granted 5 months under 1.136(a)(i). Therefore, the reply brief filed on November 3, 2003 is timely in this instance.

Applicant argues that the Exhibits filed with the reply briefs are not "new evidence" in the context of 37 CFR 1.195 but merely a showing of "well-known scientific understanding all published and available to those of ordinary skill". In response 37 CFR 1.195 states: "*Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented*". Webster's II New Riverside University Dictionary, 1984 defines an Exhibit in law as "To present or introduce officially". The three Exhibits introduced by the applicant are clearly exhibits within the meaning of 37 CFR 1.195.

Lastly, applicant argues that the examiner first raised the issue in the examiners answer therefore preventing this evidence from being earlier presented. The issue at hand is whether carbonate increases the amount of carbon monoxide when it is used as a coolant. Applicant *for the first time during prosecution* in the Appeal Brief raised the issue that Grebert et al teach away from additional carbon monoxide. Therefore adding a carbonate as a coolant wouldn't have been obvious because it would allegedly increase the amount of carbon dioxide and therefore carbon monoxide. The examiner disagreed in the examiners answer and in the reply brief, the exhibits were presented to provide support for applicants allegation in the Brief. It is noted that the same issues were before the applicant during first action although the argument was not made by applicant until after the closing of prosecution. Thus, the fact that the examiner first raised the issue in the examiners answer is not well-taken in that the examiners action was merely in response to a new issue being presented by the applicant in the appeal brief. There was no reason why this issue could not have been made in response to the first Office action. Therefore, there is not a sufficient showing or justification as to why this exhibit could not have been earlier presented.

The applicant's petition for entry of either of the reply briefs filed on September 2, 2003 and November 3, 2003 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."



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